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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,664	05/22/2006	Masanori Suzuki	280939US0PCT	7219
22850	7590	05/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
AHMED, SHEEBA				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
05/05/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/559,664

**Applicant(s)**

SUZUKI ET AL.

**Examiner**

SHEEBA AHMED

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 12/05; 2/06; 3/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-4 and 6-8 (claim 5 is canceled) in the reply filed on February 11, 2008 is acknowledged. Applicants submit that the claims of Groups I and II are integrally linked as a product, and a method for making said product. Applicants argue that:

(1) It has been held that product and method for making said product are properly presented as a single invention wherein the sole disclosed utility of the product is that recited in the specification,

(2) Restriction between a product and a process for the production of said product is only proper when the product can be produced by another method,

(3) Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. 803),

(4) Applicants submit that while PCT Rule 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(e) provides in relevant part that "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to products and the manufacture of said product." The determination of whether a group of inventions is so linked as to form a single general inventive concept should be made without regard to whether the inventions are claimed as separate claims or as alternative within a single claim, and

(5) In the instant application the claims of Groups I and II are classified in the same class/subclass so that the invention does not present a burdensome search.

However, the Examiner disagrees. Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is relevant in the national phase. PCT Rule 13.1 and 13.2 are followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. Furthermore, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art.

Hence, the restriction requirement is maintained.

**Claims 1-4 and 6-12 are pending of which 1-4 and 6-8 are now under consideration.**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a transparent sheet, characterized in that it consists of a transparent flexible composition layer which comprises 500 to 5,000 parts by mass of a **liquid material** (B) based on 100 parts by mass of a thermoplastic elastomer component (A) which is **one or more types** of a hydrogenated block polymer of a conjugated diene, an ethylene- $\alpha$ -olefin-based rubber, a nitrile-based rubber, an acrylic-based rubber, a thermoplastic polyolefin elastomer, a thermoplastic polyurethane elastomer, a thermoplastic polyester elastomer, a polyamide elastomer and a diene-based elastomer, and has a total transmittance of 90% or higher at 25°C and at a thickness of 0.5 mm. Similarly, claim 8 recites that the liquid material (B) is a liquid material having a kinematic viscosity of not higher than 500 mm<sup>2</sup>/s at 40°C and being nonvolatile at a temperature. Are the Applicants claimed the transparent sheet before it is dried or cured? Or are the claims directed to a solid transparent sheet comprising the thermoplastic elastomer composition?

Claim 4 recites that the thickness of the transparent flexible composition layer is 2.0 mm or less, and **total thickness** is 10 mm or less. Does the total thickness refer to the total thickness of the transparent sheet or just the transparent flexible composition layer?

Claim 6 depends on claim 1 and recites that the hydrogenated block polymer of a conjugated diene is a hydrogenated block polymer by hydrogenating a block polymer

having, in its molecule, at least one butadiene polymer block (I) having a vinyl bond content of 5 to 25% in the block and at least one polymer block (II) having a mass ratio of a conjugated diene to other monomer of (106 to 50)/(0 to 50) and having a vinyl bond content of 25 to 95% by mass. Neither claim 1 nor claim 6 positively recite the hydrogenated block polymer.

Claim 7 recites that the thermoplastic elastomer component (A) further comprises other elastomer (A-2). Is claim 7 simply reciting that the thermoplastic elastomer component comprises two elastomers?

Appropriate correction or clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiharada et al.(US 5744534 A).

Ishiharada et al. disclose a light scattering material prepared by mixing with and dispersing in a transparent elastomer matrix particles of a transparent material. The transparent material is flexible, easy to handle, easy to process, inexpensive to manufacture, and highly efficient to scatter light. The method of making the transparent material comprises mixing with and dispersing in a transparent elastomer matrix having

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a glass transition temperature of lower than room temperature, a transparent material having a different index of refraction from the matrix; by mixing with and dispersing in a monomer which is to polymerize into a transparent elastomer having a glass transition temperature of lower than room temperature, a transparent material having a different index of refraction from the transparent elastomer, and causing the monomer to polymerize; or by mixing with and dispersing in a transparent elastomer matrix having a glass transition temperature of lower than room temperature, a monomer which is to polymerize into a polymer having a different index of refraction from the transparent elastomer, and causing the monomer to polymerize; there is obtained a light scattering material comprising a transparent elastomer matrix having a glass transition temperature of lower than room temperature in which particles of a transparent material having a different index of refraction from the matrix are dispersed. The transparent elastomer matrix may be selected from transparent polymers having a T<sub>g</sub> of lower than room temperature. Exemplary polymers include polyvinyl acetate, polyethylene-vinyl acetate copolymers, polyethylene-polyvinyl alcohol copolymers, polyisoprene rubber, polybutadiene rubber, styrene-butadiene copolymers, styrene-butadiene-styrene block copolymer rubber, styrene-butadiene block copolymer rubber, styrene-isoprene-styrene block copolymer rubber, styrene-isoprene block copolymer rubber, styrene-ethylene-butylene-styrene copolymer rubber, butyl rubber, halogenated butyl rubber, chloroprene rubber, acrylic rubber, EPDM, acrylonitrile-butadiene copolymers, fluoride rubber, thermoplastic fluoride rubber, silicone rubber, polybutene, and acrylate ester polymers and copolymers. Also useful are polymerizable vinyl monomers including styrene,

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divinyl-benzene, methylstyrene, vinyl acetate, methyl vinyl ketone, phenyl vinyl ketone, and vinyl benzoate. The transparent material particles to be dispersed in the transparent elastomer matrix may be either inorganic or organic materials. Examples of the organic material include polyamides, polystyrene, polymethyl methacrylate, polycarbonate, polyvinyl chloride, polyvinylidene chloride, polyvinyl acetate, polyethylenevinyl acetate copolymers, polyvinyl alcohol, polyethylenepolyvinyl alcohol copolymers, fluoride resin, silicone resin, polyisoprene rubber, polybutadiene rubber, styrene-butadiene copolymers, butyl rubber, halogenated butyl rubber, chloroprene rubber, acrylic rubber, EPDM, acrylonitrile-butadiene copolymers, fluoride rubber, silicone rubber, ABS resin, acrylonitrile-styrene copolymer resin, styrene-butadiene copolymers, acrylonitrile-EPDM-styrene terpolymers, styrene-methyl methacrylate copolymers, methacrylic resin, epoxy resin, polymethyl pentene, allyl diglycol carbonate resin, spirane resin, amorphous polyolefin, polyallylate, polysulfone, polyallyl sulfone polyether sulfone, polyether imide, polyimide, polyethylene terephthalate, diallyl phthalate, polyester carbonate, paraffin, polybutene, and polyisobutylene, in powder, fiber or beads form. (See entire document; specifically see Abstract, col. 1, lines 6-10, col. 2, lines 1-8, col. 3, lines 43-60 and col. 4, lines 12-52). All limitations of claims 104 and 6-8 are disclosed in the above reference.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEEBA AHMED whose telephone number is



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(571)272-1504. The examiner can normally be reached on Monday-Friday from 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheeba Ahmed/  
Primary Examiner, Art Unit 1794